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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Lynn Holm Blagg et al. Application No.: 09/298,521 Filed: April 23, 1999 For: METHOD FOR DEFINING A RELATIONSHIP BETWEEN AN ACCOUNT AND A GROUP Customer No.: 20350	Art Unit: 3624 Examiner: Alain L. Bashore **APPELLANTS' SUPPLEMENTAL APPEAL BRIEF**

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Sir:

Appellants offer this Supplemental Appeal Brief in support of the Request for Reinstatement of Appeal submitted herewith. This Brief is submitted in triplicate as required by 37 C.F.R. § 1.192(a)

1. Introduction

The present application has taken a tortuous path to reach this point in its prosecution. Appellants have twice sought review of the Examiner's rejections, only to have prosecution reopened on highly suspect grounds. After Appellants noticed this appeal and filed their opening appeal brief, prosecution was reopened, not with any action on the merits of the

claims, but instead with a requirement for restriction, despite the fact that the claims already had been finally rejected (therefore arguably rendering the restriction requirement improper under 37 C.F.R. § 1.142(a)). After Appellants attempted to reinstate the appeal, the Examiner once again reopened prosecution, only to issue a variety of rejections under 35 U.S.C. §§ 101, 102, 103 and 112, none of which had any substantial basis. Appellants have again requested reinstatement of this appeal, seeking only the review statutorily guaranteed by 35 U.S.C. § 134(a).

2. Real Party in Interest

The real party in interest is First Data Corporation.

3. Related Appeals and Interferences

It is not believed that any other appeals will directly affect, or be directly affected by, this appeal. However, Appellants have appealed the examiner's rejection of the claims in U.S. Patent Application No. 09/298,417, which shares a common specification and filing date with the application at issue in this appeal brief. Further, the aforementioned appeal stems from prosecution proceeding in front of the same examiner, Examiner Bashore, as that of the present application. Accordingly, the aforementioned appeal may have some bearing on the Board's decision in the pending appeal.

In addition, Appellants have filed concurrently herewith a Petition under 37 C.F.R. § 1.144 from Requirement for Restriction in response to the Office Action mailed November 3, 2002 (Paper No. 23), which made final a requirement for restriction of the claims. As outlined below, it is believed that the Commissioner's decision on the Petition will have some bearing on the status of certain issues in this appeal.

4. Status of Claims

Claims 1-22 currently are pending in the application. An Office Action mailed July 26, 2002 (Paper No. 5) finally rejected all pending claims in the application. In response, Appellants filed a Notice of Appeal on August 12, 2002 and an Appeal Brief on August 15, 2002. In lieu of filing an Answer, the Examiner mailed a new Office Action on May 30, 2003 (Paper No. 19), requiring a restriction between pending claims 1-18 (Restricted Group I) and 19-22 (Restricted Group II) (the "Restriction Requirement"). (According to the Restriction

Requirement, both Restricted Group I and Restricted Group II are drawn to methods classified in class 705, subclass 35, raising a legitimate question as to why restriction was required). The May 30, 2003 Office Action did not include any new rejections of the pending claims.

Appellants filed a Request to Reinstate the Appeal and Supplemental Appeal Brief (the "first Supplemental Appeal Brief") on August 15, 2003, electing Group II with traverse and arguing that the Restriction Requirement was improper on a number of grounds. Again in lieu of an Answer, the Examiner mailed a new, non-final Office Action on November 3, 2003 (Paper No. 23). In that Office Action, the Examiner made the Restriction Requirement final and rejected the elected claims (claims 19-22) on new grounds. Believing the Restriction Requirement to be manifestly improper, Appellants have filed concurrently herewith a Petition under 37 C.F.R. § 1.144 from Requirement for Restriction (the "Petition")

Claims 1, 11 and 22 were amended during prosecution. Claims 2-10 and 12-21 are pending as filed. The following is the status of all claim rejections:

Prior to the Restriction Requirement, the July 26, 2002 Office Action finally rejected all pending claims (the "Original Rejections"):

- Claims 1-9 and 11-18 were finally rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,537,314 (Kanter);
- Claims 1-22 were rejected under § 102(e) as being anticipated by Fleming;
- Claim 9 was finally rejected under 35 U.S.C. § 103 as being unpatentable over Kanter, in view of U.S. Patent No. 4,837,422 (Dethloff);and
- Claims 19-22 were finally rejected under § 103 as being unpatentable over Dethloff.

After the Restriction Requirement, the November 3, 2003 Office Action, which did not address non-elected claims 1-18, withdrew the rejections of claims 19-22 and issued new, non-final rejections of the elected claims (the 'New Rejections"):

- Claims 19-22 were rejected under 35 U.S.C § 101 as being "non-statutory";
- Claims 19, 20 and 22 were rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite;

- Claims 19, 20 and 22 were rejected under § 103 as being unpatentable over U.S. Patent No. 5,826,243 (Musmanno), in view of U.S. Patent No. 6,422,462 (Cohen), and further in view of U.S. Patent No. 5,953,710 (Fleming); and
- Claim 21 was rejected under § 103 as being unpatentable over Musmanno, in view of Cohen, further in view of Fleming, and further in view of U.S. Patent No. 6,311,170 (Embrey).

As outlined more fully in the Appeal Brief and the first Supplemental Appeal Brief, it is believed that neither the Original Rejections contained in the May 30, 2002 Office Action nor the Restriction Requirement are proper. Moreover, the New Rejections have no more merit than the Original Rejections. All of the New Rejections are at issue in this appeal, and, depending on the Commissioner's decision on the Petition, the Original Rejections may be at issue in this appeal as well. For purposes of this second Supplemental Appeal Brief, it will be assumed that the Commissioner will grant the Appellants' Petition and withdraw the Restriction Requirement, so this second Supplemental Appeal Brief addresses both the Original Rejections and the New Rejections.

4. Status of Amendments

An amendment has been filed concurrently herewith. The amendment amends only a portion of the written description first objected to in the November 3, 2003 Office Action; the amendment does not amend any claims. Appellants do not know whether the amendment has been entered by the Examiner. No other amendments have been filed subsequent to the mailing of the final rejections mailed May 30, 2002.

5. Summary of the Invention

Various embodiments of the present invention provide methods for defining relationships between accounts such that group processing is facilitated, while one or more accounts in the group are processed at the account level independent from one or more other accounts in the group. (Application, p. 11, ll. 16-19; p. 18, ll. 5-11). Thus, as just one example, a group may comprise two or more independent accounts. A single payment may be received on

behalf of the group, and can be divided at the group level into portions allocated to each of the independent accounts. (*Id.*, p. 11, ll. 15-30; p. 22, ll. 30-39). The portions can then be applied as if two distinct payments were received, and each of the individual accounts settle as if they were not related to the group. (*Id.*, p. 15, l. 30 - p. 17, l. 20). In this way, an issuer can maintain existing individual account processing, while providing benefits associated with grouping accounts. Said another way, an issuer is not required to modify existing accounts and/or processing thereof to provide for group advantages. Further, this provides an ability to join accounts representing different products that inherently process independently to get the benefits associated with grouping. (*Id.*, p. 14, l. 20; p. 18, ll. 21-30).

Relationships between the accounts and the group are defined by a dependent strategy which includes a definition of, for example, how a statement for the dependent account is to be generated in relation to the group, directions for communicating with the owner of the account and/or others in the group, and/or reward pooling between the account and other accounts in the group. (*Id.*, p. 23, l. 32 - p. 24, l. 26). Thus, for example, an owner of a dependent account can receive information about transactions in that dependent account, and in some cases other dependent accounts within the group, while an owner of another dependent account within the group may not receive any correspondence about the owned dependent account, or other accounts within the group. (*Id.*).

In addition, some embodiments of the present invention provide methods for modifying relationships between accounts and groups to which the accounts are associated. (*Id.*, p. 28, l. 37 - p. 32, l. 12). Thus, as just one example, a group may consist of one or more dependent accounts, and a key account owned by a primary owner who is the intended recipient of group correspondence and/or primarily liable for various accounts within the group. Such embodiments of the present invention provide methods for modifying the key account, and thus the primary owner of the group. (*Id.*, p. 30, ll. 22-32). In particular embodiments, an owner of a dependent account within the group becomes the primary owner, while the primary owner is switched to dependent status. (*Id.*) In yet other examples, two or more owners are designated as primary owners. (*Id.*, p. 20, ll. 31-40.)

In yet another example, a dependent account can be moved outside of the group, while the relationship of other accounts to the group remain unchanged. (*Id.*, p. 29, l. 37 - p. 30,

l. 16). This is particularly valuable in a situation where a minor child owns a dependent account in a group which the parent is the primary owner. (*Id.*, p. 29, ll. 5-11). Initially, all communications are directed to the parent and the parent holds the liability for the account. (*Id.*). Later, the child may become a college student with joint liability for the account and responsibility for the monthly payment of the account. (*Id.*). As such, communications regarding the account may be directed to both the primary owner of the group, the parent, and the owner of the dependent account, the child. (*Id.*). Yet later, the child may become financially independent of the parent, at which time the child may remove the same dependent account from the group, and be the sole recipient of all communications and liabilities associated with the account. (*Id.*).

Other examples include modifying directions for communicating with the owner of one dependent account while retaining the previous communications with account owners associated with other accounts in the group. (*Id.*, p. 41, l. 22 - p. 42, l. 41). Thus, for example, an elderly parent on vacation may have all account communications directed to a child holding another account in the group while the parent is on vacation, and the communications redirected to the parent when they return from vacation.

6. Issues

Certain issues identified in Appellants' Appeal Brief subsequently were mooted by the November 3, 2003 Office Action, which withdrew the outstanding rejections of claims 19-22 and lodged new rejections against those claims. For consistency, numbering herein of the issues adhere to the numbering scheme of the Appeal Brief, and the mooted issues have been described as such. In addition, this second Supplemental Appeal Brief addresses four new issues raised by the November 3, 2003 Office Action, which are denoted by numerals VII-X, below.

The remaining issues were discussed in detail in the Appellants' Appeal Brief and remain pending in this appeal only to the extent the Commissioner grants the Appellants' Petition from the Restriction Requirement.

ISSUE I. Whether Kanter fails to disclose defining relationships between accounts and a group, where accounts within the group are related to different products.

ISSUE II. Whether each of Kanter and Fleming fails to disclose defining relationships between accounts and a group to facilitate group processing while maintaining independent processing of the accounts.

ISSUE III. (Moot)

ISSUE IV. Whether each of Fleming, Dethloff, and Kanter fails to disclose modifying a dependent account within an account group to be a key account within the account group.

ISSUE V. (Moot)

ISSUE VI. Whether each of Kanter and Fleming fails to disclose modifying the relationship of one account with the group, while maintaining the relationship of another account with the group.

ISSUE VII. Whether claims 19-22 are valid under 35 U.S.C. § 101 as being directed toward statutory subject matter.

ISSUE VIII. Whether claims 19, 20, 22 are valid under 35 U.S.C .§ 112, ¶ 2 as particularly pointing out and distinctly claiming the subject matter regarded by Appellants as the invention.

ISSUE IX. Whether claims 19-21 are valid under 35 U.S.C. § 103(a) over any combination of U.S. Patent No. 5,826,243 (Musmanno), U.S. Patent No. 6,422,462 (Cohen), U.S. Patent No. 5,953,710 (Fleming), and U.S. Patent No. 6,311,170 (Embrey).

ISSUE X. Whether claim 22 is valid under 35 U.S.C. § 103(a) over any combination of U.S. Patent No. 5,826,243 (Musmanno), U.S. Patent No. 6,422,462 (Cohen), and U.S. Patent No. 5,953,710 (Fleming).

7. Grouping of the Claims

It is Appellants' position that all pending claims are patentable over each of the cited references, whether asserted separately or in combination. The basis for such patentability depends upon different reasons that vary across the following claim groups and, for the purposes of appeal, the patentability of individual claims do not stand or fall based on a holding specific to any of the following groups.

Claims 1-10 fall together into Group I. Independent claim 1 provides a method for defining relationships between a first account and a group and a second account and the group. The first account is associated with a first product and the second account is associated with a second product.

Claims 1-18 fall together into Group II. Independent claim 1 provides a method for defining relationships between accounts and a group to facilitate group processing while maintaining independent processing of the accounts. Independent claim 11 provides a somewhat similar method that includes, *inter alia*, associating a dependent strategy with a dependent account within a group that includes at least the dependent account and another account. The other account is processed independent from the dependent account. Again, somewhat similarly, independent claim 16 provides a method facilitating group level processing while maintaining independent processing of accounts within the group.

Claims 19-21 fall together into Group III. Independent claim 19 provides a method for maturing a dependent account that includes, *inter alia*, modifying the relationship between a dependent account and a group to which the dependent account belongs, such that the dependent account becomes a key account within another group and the owner of the dependent account becomes the primary owner of the other group.

Claims 9 and 22 fall together into Group IV. Independent claim 22 provides a method for maturing a dependent account that includes, *inter alia*, modifying the relationship between a dependent account and a group to which the dependent account belongs, such that the dependent account becomes a key account within the same group and the owner of the dependent account becomes the primary owner of the group. Similarly, dependent claim 9 provides for modifying ownership of the group by changing the status of one of the accounts within the group.

Claims 19-22 fall together into Group V. Independent claim 22 provides a method for maturing a dependent account that includes, *inter alia*, modifying the relationship between a key account in a group to which the key account belongs, such that the key account becomes a dependent account within the same group. Claim 19 provides a similar limitation.

Claims 4, 15 and 17 fall together into Group VI. Dependent claim 4 provides the method of independent claim 1, where the relationship between one account and a group is

modified, while the relationship between another account and the group is maintained. Dependent claims 15 and 17 include similar limitations.

7. Argument

A. Original Rejections

As noted above, Issues III and V have been mooted by the New Rejections (which are addressed below as Issues VII-X in the "New Rejections" section) and therefore will not be addressed herein. Also as noted above, Issues I, II, IV, and VI remain in the appeal only to the extent Appellants' Petition is granted by the Commissioner. On the assumption that Appellants' Petition will be granted, however, these issues are addressed below:

Issue I, Group I. Claims within Group I include defining relationships between a first account and a group and a second account and the group. (*E.g.*, Application, claim 1). The first account corresponds to a first product and the second account corresponds to a second product. (*Id.*). Thus, the group encompasses multiple products such that, for example, one credit card product can be combined with a different credit card product. (Application at p. 7, ll. 23-31). As one example, a MASTERCARD product can be grouped with a VISA product. (*Id.*).

The Examiner rejects claims within Group I under 35 U.S.C. § 102 under Kanter. (Office Action of November 27, 2001, at ¶ 2; *accord* Office Action of July 26, 2002, ¶ 3)[1] (simply stating "[t]he claims are rejected as set forth in the previous office action"). However, the Examiner fails to identify anywhere in Kanter that such a limitation is disclosed. Rather, the Examiner's rejection simply ignores the limitation.

Kanter discloses an incentive consolidation platform where a single participant account acts as a central storage of qualifying purchase history, and bonuses earned. Via such an incentive consolidation program, a company can advertise, or otherwise encourage purchases of the company's products by a consumer. (Kanter, c. 12, l. 49 - c. 15, l. 60). In Kanter's incentive program, "[p]articipants need only one card or account number to participate in multiple

[1] Throughout this second Supplemental Appeal Brief, reference is made to both the November 27, 2001 Office Action (Paper No. 5), which substantively rejected the claims at issue, and the July 26, 2002 Office Action (Paper No. 6), which made final the rejections of the November 27, 2001 Office Action but provided no rationale for the rejections other than remarking that "the claims are rejected as set forth in the previous office action." (*E.g.*, Office Action of July 26, 2002, ¶ 3).

sponsoring company programs . . ." (*Id.*, c. 17, ll. 6-7). Indeed, one of the explicit purposes of Kanter is to "eliminate . . . the need for issuance of multiple cards, credit lines, and statements to an individual that participates . . .," (*Id.*, c. 14, ll. 11-13). Kanter, therefore, provides for a single, consolidated account, not a first account corresponding to a first product and a second account corresponding to a second product.

Thus, not only does Kanter fail to disclose each element of Appellants' Group I claims, it actually teaches away from such claims. As Kanter fails to disclose "[t]he identical invention . . . shown in as complete detail as is contained in the . . . claim," MPEP § 2131 (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), the rejection fails and should be withdrawn and the claims allowed.

Issue II, Group II. Claims within Group II include facilitating group level processing related to accounts within a group, while maintaining independent processing of the accounts. (*E.g.*, Application, claim 1). Maintaining such independent processing avoids various disadvantages exhibited by the cited art, and discussed in detail in the background of Appellants' application. (*Id.*, p. 2, l. 8 – p. 7, l. 20). In two separate § 102 rejections, the Examiner cites the Kanter and Fleming references against the claims in Group II. (Office Action of November 27, 2001, ¶¶ 2 and 3; *accord* Office Action of July 26, 2002, ¶¶ 3 and 4 (simply stating "[t]he claims are rejected as set forth in the previous office action"). The rejections, however, fail to address this limitation of the Group II claims. In fact, the application discusses and distinguishes the features of the cited art, (*see* Application, p. 4, l. 12 – p. 7, l. 14), so it should not come as any surprise that the cited art fails to address these elements of Appellants' claims. Nonetheless, the Examiner's maintenance of the rejections of the Group II claims evidences the Examiner's failure to give weight to these elements.

More particularly, Fleming teaches an approach whereby a parent can provide a child with access to a credit card. (Fleming, c. 3, ll. 11-31 (discussing "a method and system . . . [that] includes a separate credit card account for a child which is linked to a parent's credit card account")). Such an approach was discussed in the background of Appellants' application where three avenues of providing a child with a credit card are discussed. The three avenues include: "1) provid[ing] a child an additional card on the parent's account, 2) provid[ing] the child with a

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card on an account where the child is the primary user and the parent is the responsible party, [and] 3) provid[ing] the child with a secured card by providing collateral for the account." (Application, p. 3, ll. 24-31). Fleming simply discloses the second and third options, but does not address Appellants' invention as claimed. As discussed by Appellantss, each of the approaches has disadvantages which are also evident in Fleming. (*Id.*, p. 3, l. 32 - p. 4, l. 3).

In relation to the second option, Fleming discloses a method for providing a child with a credit card on an account where the child is the primary user and the parent is the responsible party. To do this, a credit card account held by the parent is imbedded with the child's account number and a credit card account held by the child is imbedded with the parent's credit card account number. (Fleming, c. 6, ll. 48-54). In this way, the parent's and the child's account are tied together such that they do not process independently at the account level. One disadvantage of tying the accounts together at the account level "is that the parent's access to credit may be reduced." (Application, p. 3, ll. 35-40). This is in fact one of the disadvantages of Fleming. (*See e.g.*, Fleming, Fig. 6, el. 108 & c. 10, ll. 43-47).

Rather than disclosing independent account processing, the methods of Fleming actually embrace the opposite approach, wherein the accounts are processed dependently at the account level. As one example, the parent's account in Fleming includes charges for both the parent's and the child's accounts with the charges for both the parent's and the child's accounts being used to compute the interest which is accrued to the parent's account. (*Id.*, c. 7, ll. 33-37). Thus, the "invention [of Fleming] incorporates processing such that interest charges do not accrue against the child's account . . . [as] the child's charges are part of the parent's account balance due and will result in interest charges to the parent's account . . ." (*Id.*, at c. 12, ll. 38-42). As with any credit card account, if a parent does not make a complete payment (including both parent's and child's portions), interest charges will accrue on the unpaid portion. (*Id.*, c. 12, ll. 36-38). Even where a child makes a payment, that payment is applied to the parent's account balance. (*Id.*, c. 12, ll. 46-48). As such, the accounts in Fleming process dependently at the account level, in direct opposition to the Group II claims.

In relation to the third option, Fleming discloses a method whereby a parent uses a balance deposited in relation to a debit card to secure a child's credit card. (*Id.*, c. 12, l. 57 – c. 13, l. 15). As discussed in Appellants' specification, "the disadvantage of providing the child

with a secured card by providing collateral for the account is that the collateral is committed to secure the account regardless of the amount of activity on the account." (Application, p. 3, l. 40 - p. 4, l. 1). Again, the same disadvantage is apparent in the method proposed in Fleming, and, importantly, Fleming fails to teach or suggest that the accounts could be processed independently at the account level. Moreover, Fleming fails to disclose teach or suggest how this method might be modified to operate in the manner of the method cited in the Group II claims.

With respect to Kanter, that reference likewise fails to disclose, teach, or suggest a method including grouping accounts while maintaining independent processing of individual accounts. In fact, Kanter should not be expected to disclose such a method as Kanter disparages even the use of multiple accounts, noting that, with multiple accounts, "participants [run] out of room in their wallet for extra cards and confusion created from having several charge cards . . ." (Kanter, c. 10, l. 67 - c. 11, l. 1). Kanter continues discussing the disadvantages of a multiple account system, and finishes with an omnibus rejection of such an approach, stating, "There are sure to be other similar problems relating to a participant having too many incentive cards." (*Id.*, c. 11, ll. 20-41). From this position, Kanter goes on to propose a solution that includes one card associated with a single account to which multiple companies can post incentive rewards. (*Id.*, c. 16, ll. 40-42 and 53-56). Thus, Kanter teaches consolidation into a single account, and does not teach grouping accounts in a way that maintains independent processing of the accounts.

For at least these reasons, Kanter and Fleming fail to teach (or, for that matter, even to suggest) at least one element of the Group II claims, and those references therefore cannot sustain a proper § 102 rejection. The Group II claims, then are allowable over the cited references, and the rejections should be reversed.

Issue IV, Group IV. Claims within Group IV include maturing a dependent account within an account group to be a key account within the same account group. (*E.g.*, Application, claim 9). As an example, such an approach can include changing the recipient of communications within an account group. Thus, for example, in the case of a primary owner that leaves on vacation, responsibilities of the primary owner can be diverted to an owner of one of the dependent accounts within the group.

Claim 9 stands rejected on several grounds. First, the Examiner rejects claim 9 under § 102 as being anticipated by Kanter (Office Action of November 27, 2001, ¶ 2; *accord* Office Action of July 26, 2002, ¶ 3); next the Examiner rejects claim 9 under § 102 as being anticipated by Fleming (Office Action of November 27, 2001, ¶ 3; *accord* Office Action of July 26, 2002, ¶ 4); then, expressly admitting that "Kanter does not disclose group membership modification," the Examiner proceeds to reject claim 9 under § 103 as unpatentable over the combination of Kanter and Dethloff (Office Action of November 27, 2001,¶ 5; *accord* Office Action of July 26, 2002, ¶ 6).

Unfortunately, none of the references cited by the Examiner teaches (or even suggests) the limitations of claim 9. For one thing, as noted above, the Examiner expressly admits that Kanter fails to teach the limitations of claim 9.[2] In this regard, the Examiner is correct: Kanter does fail to anticipate any of the claims in Group IV.

The rejections over Fleming are equally unfruitful. In particular, the Examiner asserts that Fleming discloses "maturing a dependent account into a key account . . . at column 16, line 1 et seq." (Office Action of November 27, 2001, ¶ 3; *accord* Office Action of July 26, 2002, ¶ 4). Fleming provides no such disclosure, motivation or suggestion, however. While the cited portion of Fleming (c. 16, ll. 4-7) does teach that "one parent account [is] designated as a 'primary' account whose account number is used in the child account record Parent Account Number field 44," it fails to disclose that the child account (or for that matter, any other parent account) might be matured into the primary account. Indeed, there would be no motivation to do so, since the child account presumably always would be subsidiary to the parent account. Given the features available to the primary account (credit limits on the child account, inclusions of child transactions on parent statement, etc.), it would not even be desirable to mature the child account–why would a parent desire to let his/her child set the parent's credit limits? It is only in hindsight that one might even find a motivation to modify Fleming to read on the limitations of claim 9, and such hindsight is not acceptable. MPEP § 2141.

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[2] In light of the Examiner's admission, there can be no serious dispute that the Examiner's rejection of claim 9 under § 102 in light of Kanter is improper.

This use of hindsight also pervades the Examiner's interpretation of Dethloff. Dethloff discloses a "multi-user card" that allows a cardholder to assign rights to "a third person (sub-user)." (Dethloff, c. 4, l. 6; c. 5, ll. 13-14). Such a card is particularly useful to allow a cardholder to permit their card to be used by a third party. (*Id.*, c. 3, ll. 44-46). The function of Dethloff is manifest in an example Dethloff describes of the advantages of such a multi-user card. (*Id.*, c. 7, ll. 23-36). In the example, a company is able to allow an employee to make charges to the company's account using the company's card. (*Id.*) As noted by the Examiner, Dethloff (c. 5, ll. 13-15) does allow a primary user to "assign rights" to a sub-user; this functionality is a far cry from the limitations of claim 9.

Notably, Dethloff does not teach that this "multi-user card" is associated with more than one independent account, let alone even suggest that a dependent account might be changed to a key account. In other words, Dethloff nowhere discloses the proposition for which the Examiner cites it. Dethloff simply provides no disclosure, suggestion, motivation, or even possibility for maturing a sub-user's independent account (which does not even exist in Dethloff), to a primary account (which also does not exist in Dethloff).

Thus, taken either alone or in combination, neither Kanter, Fleming nor Dethloff teach or even suggest the limitations of the Group IV claims, and the Examiner's rejections of those claims should be reversed for at least this reason.

Issue VI, Group VI. Claims within Group VI include modifying the relationship of one account to the group, while maintaining the relationship of another account within the group constant. (*E.g.*, Application, claim 4). Of note, the Examiner fails to even address this limitation in the rejections based on Kanter. (*See* Office Action of November 27, 2001, ¶ 2; *accord* Office Action of July 26, 2002, ¶ 3). As discussed above, Kanter discloses a consolidated account, not a set of independent accounts. In the system of Kanter, there is no relationship to maintain when the consolidated account is modified. Thus, Kanter does not disclose this limitation.

Fleming also fails to disclose the element at issue, although the rejection based on Fleming at least admits the existence of the element. (Office Action of November 27, 2001, ¶ 2; *accord* Office Action of July 26, 2002, ¶ 3). The rejection states that the element is "inherently disclosed, e.g., for multiple dependents [at] column 3, line 50 et seq . . .". (*Id.*) Any reasonable

reading of Fleming illustrates that this proposition simply is not true. Fleming discloses the possibility of adding more than one child to a parent's account. Fleming, however, does not disclose, teach or suggest that, in situations where multiple children are added to the parent's account, the modification of one child's account will not modify other accounts. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency. MPEP § 2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)). Rather, "[to] establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described, and that it would be so recognized by persons of ordinary skill." *Id.* § 2112 (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-1951 (Fed. Cir. 1999)). Such inherency does not exist in this case. In fact, the disclosure suggests just the opposite: As each of the parents and children share the same credit limit, a modification of one child's account will likely modify other accounts in the group by modifying the shared credit limit.

Since cited references fail to disclose (either expressly or inherently) each of the limitations of the Group VI claims, those claims are allowable over the Examiner's rejections, and the rejections therefore should be reversed.

B. The New Rejections

After over two years of examination of the claims substantially as filed (including Appellants' filing of their Appeal Brief), the Examiner, apparently for the first time, decided that the claims pending in the application were directed to two different inventions and required the restriction of those claims. Then, after Appellants traversed the Restriction Requirement in their first Supplemental Appeal Brief, the Examiner found (again, apparently for the first time) that the elected claims were directed both indefinite and directed to non-statutory subject matter. Nothing, other than the Appellants' demonstrated willingness to appeal the Examiner's prior art rejections, has changed substantially since the claims were first examined, and the Examiner's new, non-art rejections must be considered inherently suspect. Similarly, the Examiner's new art-based rejections, while citing some new references, cover no new ground, and they are no more persuasive than either the Original Rejections or the new, non-art rejections. Each of the Examiner's new grounds of rejection will be dealt with in turn:

Issue VII, Group V. Claims 19, 20 and 22 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. (Office Action of November 3, 2003, ¶ 6.) Attempting to explain these rejections, the Examiner states that "the method claims as presented do not claim a technological basis in the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. [§] 101." (*Id.*) As authority for this proposition, the Examiner cites this Board's decision in *Ex parte Bowman*, 61 USPQ2d (BNA) 166, 1671 (Bd. Pat. App. & Inter. 2001) (unpublished). Although *Bowman* was an unpublished decision, the Examiner states that he finds the reasoning persuasive.

The reasoning in *Bowman*, however, compels the conclusion that the claims in the present application, unlike the claim at issue in that case, do in fact recite statutory subject matter. In Bowman, the Board found dispositive the fact that neither the claim nor the Appellants' specification ever disclosed any technological basis for the claimed invention:

> Appellant has carefully avoided tying the disclosed and claimed invention to any technological art or environment. As noted by the examiner, the disclosed and claimed invention is directed to nothing more than a human making mental computations and manually plotting the results on a paper chart. The Examination Guidelines for Computer-Related Inventions are not dispositive of this case because there is absolutely no indication on this record that the invention is connected to a computer in any manner. . . .
>
> . . .
>
> In summary, we find that the invention before us is nothing more than an abstract idea which is not tied to any technological art, environment, or machine, and is not a useful art as contemplated by the Constitution of the United States. The physical aspects of claim 1, which are disclosed to be nothing more than a human manually drawing a chart and plotting points on this chart, do not automatically bring the claimed invention within the technological arts.

Bowman, 61, USPQ2d at 1671 (citation to record omitted); *accord id.* at 1673-74 (Dixon, J. concurring) ("In the present application, the specification is silent as to the need for any apparatus to carry out the claimed process or to make the ultimate decision regarding the

value of the intangible asset."); *see also AT&T Corp. v. Excel Comms., Inc.*, 172 F.3d 1352, 1355, 50 USPQ2d (BNA) 1447, 1449-50 (Fed. Cir. 1999) (holding valid over a § 101 challenge method claims, which, although not limited to a physical implementation, were applied to realize a "useful, concrete, and tangible result").

In contrast to the *Bowman* Appellant's careful avoidance of any correlation between the claimed invention and a "technological art or environment," the specification of the present application clearly contemplates that the methods generally will be implemented by computer. For instance, the specification discloses that

> [t]he detailed description which follows is represented largely in terms of processes and symbolic representations of operations by a conventional computer. The processes and operations performed by the computer, in both a stand-alone environment and a distributed computing environment, include the manipulation of signals by a processor and the maintenance of these signals within a data set, such as a database and a data structure. Each of these data sets and data structures are resident in one or more memory storage devices. . . .
>
> For the purposes of this discussion, a method or process is generally conceived to be a sequence of computer-executed steps leading to a desired result. These steps generally require physical manipulations of physical quantities. . . . Thus, one skilled in the art will be able to implement the systems and methods of the present invention with general purpose machines or specially customized programmable devices according to the teachings herein.

(Application, p. 14, l. 38 – p. 15, l. 25)

With this support in the disclosure, the claims at issue here clearly are distinct from the purely mental claims addressed by the Board in *Bowman*. Moreover, each of the claims at issue produces a useful, tangible and concrete result. For instance, claim 19 recites, *inter alia,* that "the dependent account is matured into the key account for the second group and a dependent cardholder associated with the dependent account is matured into a primary owner of the second group. Under *Excel Communications*, therefore, the claims at issue here must be considered to be directed to statutory subject matter and, by necessity, to be valid under § 101.

The Examiner's rejections under § 101 therefore cannot stand, and claims 19-22 should be found allowable under § 101.

<u>Issue VIII, Group V</u>. The Examiner next attempts to assert that claims 19, 20 and 22 are too indefinite to comply with 35 U.S.C. § 112, ¶ 2, despite the Examiner's willingness to examine the claims at least twice before without any mention that the claims might be indefinite. (Office Action of November 3, 2003, ¶ 9) Regardless of the reason for the § 112, ¶ 2 rejections, they are not justified by either the language of the claims or prevailing authority, and the rejections therefore should be reversed.

With respect to claims 19 and 22, the Examiner asserts that the claim recites "'modifying a relationship parameter . . . . . ', but thereafter is recited account dependency relationships without further recitation as to how this relates to the parameter. Even a cursory reading of the claims at issue, however, belies the Examiner's contention. For instance, claim 19 recites, *inter alia*, "modifying a relationship parameter that defines the dependent account's relationship to the group from dependent to key. . . ." Clearly, therefore, the relationship parameter <u>defines</u> the dependent account's relationship to the group. The quoted claim element, then, recites modifying this parameter from dependent to key. One skilled in the art would unmistakably recognize that the relationship parameter can denote the dependent account's relationship with the group, and that the parameter can have values that, *inter alia*, correspond to either a dependent account or a key account, such that modifying the parameter can change the dependency relationship between the account and the group. Presumably, the rejection of claim 22 relates to similar language in that claim.

Appellants submit that claims 19 and 22 do in fact particularly point out and distinctly claim the subject matter regarded as the invention. Indeed, it would be difficult to understand how the claims could be amended to more clearly claim the invention. Thus, the § 112, ¶ 2 rejections of claims 19 and 22 are without merit and should be reversed.

Similarly, the Examiner's rejection of claim 20 under § 112, ¶ 2 cannot be sustained. Claim 20 recites, "maintaining account history for the dependent account by associating the account history with the key account for the second group." In rejecting the claim, the Examiner states that, "in claim 19 the dependant account is matured so there is no

longer a dependant account." In this rejection, the Examiner attempts, without justification, to impose a chronological limitation on claims 19 and 20 that the claims themselves do not support. Claim 20 clearly contemplates that, while the account remains a dependent account, it accumulates an account history, and that the account history for that account is maintained by associating it with the key account for the second group (which, of course, was the dependent account in the first group). Given the claims and the specification, one skilled in the art undoubtedly would recognize the transition of the account from dependent to key status, and would understand that claim 20 is directed toward maintaining the account history for that account during the transition from dependent to key status. As with claims 19 and 22, in fact, Appellants can fathom no language that would more distinctly claim the invention than the language already used by claim 20. The Examiner's rejection of claim 20 under § 112, ¶ 2 is unjustified, and the rejection, like those of claims 19 and 22, should be reversed.

Issue IX, Group III. The November 3, 2003 Office Action rejects claims 19 and 20 under 35 U.S.C. § 103(a) as unpatentable over Musmanno in view of Cohen and further in view of Fleming (Office Action of November 3, 2003, ¶ 11); and claim 21 under § 103(a) as unpatentable over the same references in further view of Embrey (*Id.*, ¶ 12). These new rejections, however, are no more plausible than the original rejections of claims 19-21, which the Examiner withdrew in response to this appeal, and they likewise cannot stand.

For instance, claim 19 recites, *inter alia*, "modifying a relationship parameter that defines the dependent account's relationship from dependent to key, so that the dependent account is matured into the key account for the second group and a dependent cardholder associated with the dependent account is matured into a primary owner of the second group." (Application, claim 19). This feature allows, for instance, an account that is a dependent account in one group to be matured to a key account in a different group. As an example, such an approach can include removing an account from a group such that the same account continues to operate without requiring modifications to the account. Thus, for example, in the case of a divorce, an account associated with a divorced spouse may be removed from the group, while continuing to operate as a separate account, or as a key account for a new group.

Nothing in the cited references discloses this element of claim 19. Musmanno, which the Examiner cites as the primary reference in the asserted combination, deals with asset accounts in a brokerage house, such that an account holder can have a single master account, with "a variety of subaccounts directed to a specific goal such as monthly household expenses, long term investment strategies and other financial goals." (Musmanno, c. 3, ll. 5-9) Notably, Musmanno teaches that "[s]ince the Subaccounts 30 have limited features with respect to a Master Account, fees applied to the Subaccount(s) 30 will generally be noticeably less." (*Id.*, c. 4, ll. 41-43). Thus, Musmanno unmistakably contemplates that subaccounts, which are created to hold funds <u>for a specific purpose</u>, necessarily will be subordinate (in both hierarchy and features) to a master account, such that migrating a subaccount to a master account for a different group likely would be inappropriate. In other words, since a subaccount does not have all of the features of a master account, even if a subaccount were placed in another group, it likely would not be able to function as a master account.

The reason for Musmanno's master account/subaccount structure can be found in several of the stated objects of Musmanno's invention: "It is an objected of the present invention to provide an improved brokerage/cash management system. It is another object of the present invention to enable individuals to easily and cost effectively manage their assets and have a concise, clear understanding of the value of their assets." (*Id.*, c. 2, ¶ 10-15). In fulfilling these objectives of the invention, Musmanno would have no need for the ability to mature one of its subaccounts to a master account in another group. In the context of Musmanno's invention, why would a mortgage subaccount under one master account ever need to be matured into a master account for another group?

The Examiner correctly recognizes that Musmanno fails to provide at least the following element of claim 19 set forth above, but the Examiner contends that Cohen provides the lacking disclosure. Cohen, however, deals with providing multiple, disposable (or limited use) credit cards for a credit card account: "[A] new system of disposable credit card numbers is disclosed herein. These credit cards or credit card numbers are generated for a one time, single transaction basis, after which they are disposed of, or thrown away. . . . In other embodiments, customized or limited use cards are provide. These cards are customized, preferably by the user, to suit the user's desires or needs." (Cohen, c. 2, ll. 33-37, 56-59). Cohen does not, however,

teach that each of these disposable or limited use credit cards/numbers are associated with a separate account. In fact, Cohen implicitly teaches exactly the opposite: For instance, Cohen describes as a benefit of his invention the fact that "[u]pon being used once, the credit card can be marked, if desired, to show both that it has been processed to charge money to the person's account, and to show that it is no longer usable." (*Id.*, c. 4, ll. 35-38 (emphasis added)). Cohen later notes that, under the disclosed invention, "no single number alone is capable of compromising the user's account for more than one transaction." (*Id.*, c. 3, ll. 59-60 (emphasis added)). The only reasonable implication of these passages is that Cohen contemplates that all of the disposable (or limited use) cards/numbers is associated with a single account. Thus, the portion of Cohen cited by the Examiner, which notes that "a customized credit card could be converted to a general purpose credit card," (*Id.*, c. 13, ll.15-16) can be interpreted only to mean that a "customized" card (which, in Cohen's disclosure is synonymous with a limited-use card, *see* c. 7, ll. 20-27) can be converted to a general use card. This disclosure does not even come close even to suggesting "modifying a relationship parameter that defines the dependent account's relationship to the group from dependent to key, so that the dependent account is matured into the key account for a second group and a dependent cardholder associated with the dependent account is matured into a primary owner of the second group," as claimed by claim 19.

Cohen, therefore, cannot remedy Musmanno's failure to disclose each of the limitations of claim 19. Likewise, the Examiner does not even attempt to argue that Fleming provides this missing element. For at least this reason, the asserted combination fails to disclose each of the limitations of claim 19, and that claim is allowable over the cited references.

Further, as the Examiner concedes, Musmanno fails to disclose even that a dependent account might have a dependent cardholder. (Office Action of November 3, 2003, ¶ 11). (Actually, Musmanno appears not to disclose any cardholder associated with any account, with the possible exception of a passing mention to "credit/debit card management" at column 2, lines 30-31). With respect to this failing of Musmanno, the Examiner states only that "[i]t would have been obvious to one with ordinary skill in the art to include to Musmanno et al dependent cardholders associated with dependent accounts because Fleming teaches dependent cardholders as known in the art." Even assuming Fleming taught the limitation claimed in claim 19, the mere

assertion that a feature is "known in the art" falls far short of fulfilling the Examiner's burden in formulating a § 103 rejection.

To support a prima *facie case* of obviousness under § 103, the Examiner must show some suggestion or motivation to combine cited references in the manner contemplated by the office action, and there must be some reasonable expectation of success in the combined disclosure. MPEP § 2143. Notably, "[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references." *Id.*, § 2143.01 (citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d (BNA) 1161 (Fed. Cir. 1999)). As the Federal Circuit held in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d (BNA) 1313, 1316 (Fed. Cir. 2000),

> [E]very element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

(citations omitted). Here, the Examiner has identified <u>nothing</u>, either in the references themselves or in the art generally, that would provide the required suggestion or motivation to combine the references in the manner contemplated by the Examiner. Instead, the Examiner has merely concluded, from his assertion that Fleming teaches dependent accounts as known in the art, that it would have been obvious to combine the references. This type of conclusory reasoning directly violates the Federal Circuit's mandate in *Kotzab*. Thus, not only does the asserted combination of Musmanno, Cohen and Fleming fail to teach each element of claim 19, the Examiner has not even attempted to provide a viable suggestion or motivation to combine the references in the manner indicated.

The Examiner's additional citation of Embrey in rejecting claim 21 suffers from the same deficiencies. First, the cited passage in Embrey fails to disclose the elements of claim 21. That claim, which depends from claim 19, further recites, *inter alia*, "selecting a set of dependent accounts; [and] moving the set of dependent accounts to the second group . . . ."

(Application, claim 19). The Examiner asserts that lines 10-33 from column 3 of Embrey teach these limitations. (Office Action of November 3, 2003, ¶ 12). The cited passage, however, states in its entirety:

> These and other objectives are achieved as is now described. When characterized as an improved method of making payments from a plurality of payor entities to a plurality of payee entities through a service provider, the invention consists of a number of method steps which will now be described. First, authorization is obtained from a plurality of payor entities which allows a service provider to make payments, on behalf of the plurality of payor entities, to a plurality of payee entities. Then at least one trusted intermediary financial institution is selected. The trusted intermediary financial institution periodically receives payment information and payment authorization from the plurality of payor entities. The trusted intermediary financial institution automatically transfers funds, in amounts only consistent with the payment information, to the service provider upon verification of payment authorization. Preferably, the payment information includes at least (1) an identification of each of the plurality of payee entities; (2) an identification of payment amounts for each of the plurality of payee entities; (3) a payment record identifier (also referred to as a "virtual check number") which is uniquely associated with each payment; and (4) an authorization code which is uniquely associated with each payment record identifier.

(Embrey, c. 3, ll. 10-33). Nothing in the cited passage even approaches a suggestion that accounts could be moved from one group to another. Instead, the cited passage teaches that <u>funds</u> from a plurality of payors may be transferred to a plurality of payees. Clearly, the Examiner misapprehends either the scope of claim 21, the teachings of the cited passage, or both. In any event, no reasonable review of the cited passage of Embrey could indicate that it teaches the limitations of claim 21.

Moreover, even if Embrey did teach the limitations for which it is cited, the Examiner once again fails to provide anything close to a motivation or suggestion that would justify the combination of that reference with Musmanno, Cohen and Fleming. Instead, the Examiner merely asserts that "[i]t would have been obvious to one with ordinary skill in the art

to include to Musmanno et al selecting a set of dependent accounts and moving a set of dependent accounts to a second group because Embrey teaches obligations to a group that require identification of a set of accounts." (Office Action of November 3, 2003, ¶ 12). This asserted "teaching" provides no motivation or suggestion to combine the references. As with the rejection of claim 19, the rejection of claim 21 merely concludes from the presence of the teaching itself that it would be obvious to combine that teaching with the other cited references. As stated above, this conclusory reasoning fails to carry the Examiner's burden in stating a *prima facie* case of obviousness under § 103(a).

For at least these reasons, claim 19 (and all of the claims in Group III) are allowable over the Examiner's new grounds of rejection, and those rejections should be reversed.

<u>Issue X, Group III</u>. The November 3, 2003 Office Action also rejects claims 22 under 35 U.S.C. § 103(a) as unpatentable over Musmanno in view of Cohen and further in view of Fleming (Office Action of November 3, 2003, ¶ 11). For at least the reasons stated with respect to Issue IX, claim 22 likewise is patentable over the cited references.

In addition, however, claim 22 is drawn to, *inter alia*,

> modifying a relationship parameter that defines the original key account's relationship to the group from key to dependent, so that the original key account is changed to a second dependent account and the original primary owner is changes to a second dependent cardholder; and
>
> modifying a relationship parameter that defines the original key account's relationship to the group from key to dependent, so that the original key account is changed to a second dependent account and the original primary owner is changes to a second dependent cardholder.

(Application, claim 22). The Examiner asserts that Cohen discloses these elements. (Office Action of November 3, 2003, ¶ 11). As stated above, however, Cohen does not in fact disclose even that its customized cards are in fact associated with dependent accounts, so it necessarily does not disclose changing the relationship of an account to a group from key to dependent, or from dependent to key. Even if Cohen somehow could be read in that manner however, Cohen discloses only that "a customized card could be converted to a regular, general purpose credit

card, or vice versa . . . ." (Cohen, c. 13, ll. 15-16). Cohen nowhere discloses that, in the event a general purpose card is converted to a customized card, a customized card will be converted to a general purpose card, or that a holder of the original customized card "is matured into the primary owner of the group," while a holder of the original general purpose card "is changed to a second dependent cardholder."

For at least this reason, as well as reasons discussed with respect to Issue IX, therefore, the asserted combination of Musmanno, Cohen and Fleming cannot create a prima facie case of obviousness with respect to claim 22, and the rejection of that claim under § 103(a) should be reversed.

9. Conclusion

Appellants believe that the above discussion is fully responsive to all grounds of rejection set forth in the application. Although the Examiner has attempted on numerous, varied grounds to reject the claims pending in the application, all of the asserted grounds of rejection, much like the Restriction Requirement, are without merit.

It is believed that no fee is required for filing the Request for Reinstatement of Appeal or this second Supplemental Appellants' Brief. Should the Patent Office determine otherwise, however, please deduct the requisite fee from Deposit Account 20-1430

Respectfully submitted,

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